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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,100

07/14/2006

Ali N. Syed

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EXAMINER

LEA, CHRISTOPHER RAYMOND

ART UNIT

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1619

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,100	Applicant(s) SYED ET AL.	
	Examiner Christopher R. Lea	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8-19,21-25,28-31,33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) 4,18,19 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8-17,24,25,28-31,33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a 371 (national stage application) of PCT/US05/03462 which claims benefit to US Provisional application 60/540,176.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn; however, due to applicant's amendment to the claims this action is made final (see MPEP § 706.07(d)). Applicant's amendment incorporating the limitation of "granular" into all claims necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Receipt of Amendments/Remarks filed on July 31, 2009, is acknowledged. In response to the Office action dated June 22, 2009, applicant amended claims 1, 3, 4, 8-10, 14, 16, 24, 31, 35, 36, 38, & 39, canceled no claims, and added no claims. Claims 1, 3, 4, 8-19, 21-25, 28-31, 33, & 35-40 are pending. Claims 1, 3, 8-17, 24, 25, 28-31, 33, & 35-40 are under examination.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. All new rejections applied have been necessitated by applicant's amendment to the claims. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 8, 9, & 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shultz et al. (US Patent 5,866,107) in view of Cincotta et al. (US PreGrant Publication 2002/0155962).

Applicant claims

Applicant claims a substantially anhydrous, free-flowing granular composition for hair lightening containing a peroxy salt compound and a water-dispersible, self-emulsifying, fatty acid-derived hair conditioner made up of a combination of materials.

Determination of the scope and content of the prior art (MPEP 2141.01)

Schultz et al. teach, as a whole, a bleach powder that when combined with aqueous hydrogen peroxide forms a composition for the bleaching of hair (abstract).

Schultz et al. teach a bleach powder (granular) which comprises at least one de-dusting agent and at least one peroxygenated salt which may also contain hair conditioners (column 4, lines 11-16). Schultz et al. teach that the powder compositions are mixed with aqueous hydrogen peroxide to form activated bleaching conditions (column 4, lines 16-20). Schultz et al. teach sodium and potassium persulfate as the preferred peroxygenated salts (column 4, lines 30-34).

Note that for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." (See MPEP § 211.03) Note that in claims 35-40, which use the transitional phrase "consisting of" the examiner has interpreted the de-dusting agent as an optional cosmetic adjuvant. Also note that generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the

prior art unless there is evidence indicating such concentration or temperature is critical.
(See MPEP § 2144.05 II.A)

**Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)**

The difference between the teachings of Schultz et al. and the instant claims is that Schultz et al. does not teach the claimed species of conditioners. This deficiency in Schultz et al. is cured by the teachings Cincotta et al.

Cincotta et al. teach, as a whole, a non-aqueous (hence substantially anhydrous) composition to style hair which contains many optional hair conditioners (fixatives, humectants, emollients, etc.) (abstract and claims 1-31).

Cincotta et al. teach a vast number of hair conditioners (as emollients) which may be included in combination in a hair active composition (paragraph 47). Caprylic/capric triglyceride (a fatty ester, a C3-C4 polyol ester of a C6-C22 fatty acid), glyceryl citrate/lactate/linoleate/oleate (fatty esters, glyceryl ester of a C6-C22 fatty acid and at least one acid selected from the group consisting of citric, lactic, succinic acids), and PEG-40 sorbitan peroleate (a polyethoxylated C12-18 acylated sorbitol ester) are among the emollients taught (paragraph 47). The glyceryl cocoate/citrate/lactate part of the elected species is met by the glyceryl citrate/lactate/linoleate/oleate and glyceryl cocoate taught (paragraph 47, the "/" in these names is interpreted to mean a combination of the listed monoesters, as such the combination of citrate/lactate/linoleate/oleate and cocoate necessarily includes the combination of cocoate/citrate/lactate).

**Finding of *prima facie* obviousness
Rationale and Motivation (MPEP 2142-2143)**

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to use the specifically claimed conditioners in the composition of Schultz et al. and produce the instant invention. The skilled artisan would have been motivated to incorporate the claimed conditioners because Schultz et al. teaches the inclusion of hair conditioners in the composition and Cincotta et al. teaches that the specifically claimed species are suitable as hair conditioners. It is within purview of the skilled artisan to select a known material based on its suitability for its intended use. Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle (see MPEP § 2144.07).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in using the specifically claimed conditioners in the composition of Schultz et al. and producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

5. Claims 10-17, 24, 25, 28-31, & 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. and Cincotta et al. as applied to claim 1 above, and further in view of Syed et al. (US Patent 5,756,077).

Applicant claims

Applicant claims a substantially anhydrous, free-flowing granular composition for hair lightening containing a water-dispersible, self-emulsifying, fatty acid-derived hair conditioner and a peroxy salt compound.

Determination of the scope and content of the prior art (MPEP 2141.01)

Detailed discussion of the rejection of claim 1 and the teachings of Schultz et al. and Cincotta et al. appears above.

Schultz et al. teach that the composition may contain cationic conditioning polymers (column 5, lines 1-24).

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the teachings of Schultz et al. and Cincotta et al. and the instant claims is that Schultz et al. and Cincotta et al. do not teach adding the specifically claimed hair protectants. This deficiency in Schultz et al. and Cincotta et al. is cured by the teachings of Syed et al.

Syed et al. teach, as a whole, a method for protecting chemically treated hair and a kit for using the compositions to protect hair (abstract and claims 1-26).

Syed et al. teach that compositions for protecting hair include polyols and cationic polymers (column 3, lines 35-39). Syed et al. teach that compositions for protecting hair include starch hydrolysates and polysaccharides (column 3, lines 35-62).

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Though maltodextrin is not specifically disclosed, Syed et al. teach the Hystar®, a high molecular weight starch hydrolysate of undefined structure, which by its nature likely contains maltodextrin, a lower molecular weight starch hydrolysate of undefined structure, as a synthetic byproduct. Syed et al. teach including cationic polymers in the hair protectant composition, specifically MERQUAT 100 (column 6, lines 36-51) which is a tradename for the polymer polyquaternium-6. Syed et al. teach including (in either component) a pH adjustor (column 7, lines 9-10). It would have been within the purview of the skilled artisan to optimize the pH for any desired purpose, specifically to an alkaline pH, where hair bleaching treatments containing hydrogen peroxide are more effective. Syed et al. teach that compositions for protecting hair include polyols and cationic polymers (column 3, lines 35-39). Syed et al. teach a post-treatment shampoo with a pH of 4-6 (column 11, lines 9-13). Syed et al. teach including cationic polymers (hair protective agents) in the hair conditioning composition (column 3, lines 35-39). Syed et al. teach a post-treatment shampoo with a pH of 4-6 (column 11, lines 9-13). A shampoo is an aqueous acid medium and it usually contains a nonionic polymer, cationic polymer, or both. Syed et al. teach a kit containing a bleaching composition (claim 22) and further containing a removable affixed (separately packaged) component of a shampoo (claim 26).

**Finding of *prima facie* obviousness
Rationale and Motivation (MPEP 2142-2143)**

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the hair protectant compositions of

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Syed et al. with the bleaching composition of Schultz et al. and Cincotta et al. to improve the hair's post-bleaching condition and produce the instant invention. The skilled artisan would have been motivated to add hair protectants because Syed et al. teach that bleaching and coloring hair causes long-term damage to the hair (column 2, lines 23-35); therefore, a protectant would help to reduce the damage. Further, Syed et al. teaches the possible combination of their protectant composition with a bleaching composition (column 18, lines 37-51).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in combining the hair protectant compositions of Syed et al. with the bleaching composition of Schultz et al. and Cincotta et al. to improve the hair's post-bleaching condition and producing the claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

In light of the forgoing discussion, one of ordinary skill in the art would have concluded that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3, 8-17, 24, 25, 28-31, 33, & 35-40 have been considered but are moot in view of the new ground(s) of rejection;

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however, the examiner would like to address a few points argued by the applicant in the Remarks filed July 31, 2009, in the interest of compact prosecution.

Applicant argues that Cincotta et al. has not teaching or suggestion of powdery compositions; however, the examiner views this as irrelevant. Cincotta et al. is cited to demonstrate that the claimed species of conditioners are known to be combinable, suitable for the purpose of conditioning hair, and stable in an anhydrous composition. Further, applicant argues that there is no teaching, suggestion or motivation in Syed et al. to prepare the claimed granular composition; however, the examiner does not find this convincing, as the rational motivation to combine the teachings of references need not be explicitly taught in the prior art. All the cited references teach compositions that treat hair in one way or another, hence combining them in one composition to treat hair would have been prima facie obvious to one of ordinary skill in the art.

Additionally, the examiner notes that applicant's invention is an amalgamation of various hair treating compositions and methods, wherein the prior art elements are combined using known methods to yield predictable. Note that combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art (*United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84). The examiner believes that the results presented by the examples in the specification in this case are predictable, e.g. compositions containing conditioners leave the hair in better condition than those lacking conditioner. The results shown in the examples are either subjective, or, if

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objective, of insufficient significance to be indicative of unobviousness (i.e., differences in degree versus differences in kind).

For these reasons the rejections under 35 U.S.C. § 103(a) are maintained.

Conclusion

Claims 1, 3, 8-17, 24, 25, 28-31, 33, & 35-40 are rejected. Claims 4, 18, 19, & 21-23 are withdrawn. No claims are allowed.

Applicant's amendment incorporating the limitation of "granular" into all claims necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Lea whose telephone number is (571) 270-5870. The examiner can normally be reached on Mon-Fri 8:00-4:30 ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRL

/Ernst V Arnold/
Primary Examiner, Art Unit 1616